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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,319	02/05/2007	Xaver Wirth	566/44949	5577

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BARNES & THORNBURG LLP  
750-17TH STREET NW  
SUITE 900  
WASHINGTON, DC 20006-4675

EXAMINER
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NGUYEN, XUAN LAN T

ART UNIT	PAPER NUMBER
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3657

NOTIFICATION DATE	DELIVERY MODE
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03/26/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

vrobertson@btlaw.com  
DocketingPAT-DC@btlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,319	<b>Applicant(s)</b> WIRTH ET AL.	
	<b>Examiner</b> Lan Nguyen	<b>Art Unit</b> 3657	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2 IDS</u> . | 6) <input checked="" type="checkbox"/> Other: <u>approved spec.</u>                     |

## **DETAILED ACTION**

### ***Specification***

1. The substitute specification filed on 5/4/06 has been approved and entered.

### ***Information Disclosure Statement***

2. Document DE433295 has been lined out because said document is not in the file. Please re-submit the document.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- The claimed feature “polygonal steel” is not explained in the specification to enable one of ordinary skill in the art to make use of the invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 2-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 2, it is believed that the groove is extending outward away from the center of the hub.
- Please review the claims and provide proper antecedent basis for the claimed features. For example, in claim 2, "which through hole" should be --which said through hole--. It is noted that the same deficiency exists for claimed features each radial groove, each sliding element, etc.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6, 8-11, 13-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lehmann et al. (WO 01/96758). Note that US patent 6,808,050 is being used in the rejection; since said US patent is the English equivalent of said WO document.

Re: claim 1, Lehmann shows a brake disk for a rail vehicle, as in the present invention, the brake disk comprising: a hub 16, at least one friction ring 12 having radial grooves 215 and fastened by a clamping bolt 15 to the hub, sliding elements 20 having

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a shank and being connected to the hub, the sliding elements engaging in the radial grooves for anti-rotation locking and centering of the at least one friction ring; and the sliding elements extending parallel to an axis of the clamping bolt, as shown in figure 1.

Re: claims 2 and 15, Lehmann shows the groove extending in towards or out away from the center of the hub as claimed.

Re: claims 3, 4, 6, 8, 9, 14, 16, 18 and 19, Lehmann shows hole 214 in the hub; each sliding element is a guide pin with a head in the groove as claimed; each sliding element is a straight pin with two parallel sides or a polygonal shaped head, as claimed.

Re: claims 10, 11 and 13, Lehmann further shows three sliding elements are symmetrically distributed over the circumference of the hub in figure 4 wherein they correspond with the bolts.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5, 7, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. (WO 01/96758). Note that US patent 6,808,050 is being used in the rejection; since said US patent is the English equivalent of said WO document.

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Re: claims 5, 7 and 17, the claimed features in claims 5, 7 and 17 are considered to be engineering design choices to fit a certain size and/or shape as required in order to meet certain requirements of strength and performance and would have been obvious to one of ordinary skill in the art at the time of the invention to have selected a certain size and/or shape as a routine in the engineering design process.

Re: claim 12, the number of the sliding elements are considered to be engineering design choices in order to meet certain requirements of strength and performance while provide adequate thermal expansion and would have been obvious to one of ordinary skill in the art at the time of the invention to have selected a certain number of sliding elements as a routine in the engineering design process.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gardner et al. and Tickle et al. are cited for other brakes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on Monday through Friday, 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Xuan Lan Nguyen/  
Primary Examiner  
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